

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Eric C. ANDERSON et al.

Serial No.: 09/342,680

Filed: June 29, 1999

Date: January 28, 2002

COPY OF PAPERS
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Group Art Unit: 2176

Examiner: Huynh, C.

For: METHOD AND SYSTEM FOR VIEWING IMAGES FROM AN IMAGE
CAPTURE DEVICE ON A HOST COMPUTER

3-13-02
Assistant Commissioner of Patents
Washington, D.C. 20231

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APPEAL BRIEF TRANSMITTAL LETTER


Sir:

Submitted herewith are an original and two copies of an Appellant's Brief on Appeal under 37 C.F.R. § 1.192 in connection with the above-referenced Patent application. The Brief includes an Appendix. Also submitted herewith is a Petition for Extension of Time of One Month.

Check no. 4032 in the amount of **\$430.00** is enclosed for payment of the Appeal Brief filing and extension fee. A duplicate of this sheet is attached.

Respectfully submitted,

January 28, 2002



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Attorney Docket: P160CIP/1418CIP

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APPELLANTS' BRIEF

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3/12/02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPELLANT'S BRIEF ON APPEAL Technology Center 2100

Sir:

Appellants herein file an Appeal Brief drafted in accordance with the provisions of 37

C.F.R. § 1.192(c) as follows:

I. REAL PARTY IN INTEREST

Appellants respectfully submit that the above-captioned application is assigned, in its entirety to Flashpoint Technology, Inc., of Peterborough, New Hampshire.

II. RELATED APPEALS AND INTERFERENCES

Appellants state that, upon information and belief, they are not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

03/01/2002 BNGUYEN1 00000037 09342680

02-FC:119

320.00 OP

Adjustment date: 03/04/2002 BNGUYEN1
03/01/2002 BNGUYEN1 00000037 09342680
02-FC:119 -320.00 OP

03/04/2002 BNGUYEN1 00000001 09342680 320.00 OP
01 FC:120

III. STATUS OF CLAIMS

Claims 1-20 are pending in the present application and stand rejected. Claims 4, 17 and 18 were amended in a Response dated December 4, 2000. Accordingly, Claims 1-20 are on appeal and all applied rejections concerning those claims are herein being appealed.

IV. STATUS OF AMENDMENT

All amendments to the claims have been entered.

V. SUMMARY OF THE INVENTION

The present invention provides a method and system for viewing images from a digital camera on a personal computer ("PC") without having to first load any type of communication software onto the PC. This is accomplished by automatically generating in the camera an Internet description file, such as an HTML file, that references the images stored in the camera, and then by connecting the digital camera to the PC as a mass storage device. That way, the Internet description file is easily accessible by the computer's web browser, whereby the user may view the camera images through the PC's web browser. Because *each step*, e.g., automatically generating the HTML file, mounting the digital camera to the PC, and opening the HTML file, is accomplished *without* the need for special software, the method and system of the present invention eliminates the requirement that the camera user load any type of communication software onto the host before being able to view the camera images.

Independent claim 1 recites:

1. A method for viewing images from an image capture device on a host

computer, comprising steps of:

- a) establishing communication between the image capture device and the host computer;
- b) automatically generating an Internet page description file in the image capture device that references the images stored therein;
- c) mounting the image capture device as a disk on the host computer; and
- d) opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

Independent claim 8 is a system claim reciting a host computer in communication with a digital camera of similar scope to claim 1. Claim 13, recites:

13. A computer-readable medium containing program instructions for viewing images from a digital camera on a host computer, the program instructions for:

- a) automatically generating an HTML file that references the images stored in the digital camera;
- b) establishing a Universal Serial Bus (USB) connection between the digital camera and the host computer; and
- c) identifying the digital camera to the host computer as a mass storage device class whereby the digital camera appears to the host computer as a disk, thereby allowing a user to open the HTML file in a web browser on the host computer, wherein the images stored in the digital camera are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

VI. ISSUES

The issue presented is:

1. Whether claims 1, 8, 11-13 are unpatentable under 35 U.S.C. §103(a) over Xu (U.S. Patent No. 5,848,420) ("Xu") in view of Narayan et al. (U.S. Patent No. 6,035,323) ("Narayan").
2. Whether claims 2-5, 9-10, 14-18 are unpatentable under 35 U.S.C. §103(a) over Xu and Narayan, as applied to claim 1, and further in view of Cohen et al. (U.S. Patent No. 5,805,829).
3. Whether claims 6-7 and 19-20 are unpatentable under 35 U.S.C. §103(a) over Xu and

Narayan, as applied to claim 5, and further in view of Wang et al. (U.S. Patent No. 6,058,428).

VII. GROUPING OF CLAIMS

Appellant hereby states that claims 1-7 constitute one group. Claims 8-12 form another group. Claims 13-20 form one group. Accordingly, claims 1-20 constitute a total of three (3) groups.

VIII. ARGUMENTS

A. Summary of the Applied Rejections

In the Final Office Action, the Examiner rejected claims 1, 8, 11-13 under 35 U.S.C. §103(a) as being unpatentable over Xu (U.S. Patent No. 5,848,420) ("Xu") in view of Narayan et al. (U.S. Patent No. 6,035,323) ("Narayan"). Claims 2-5, 9-10, 14-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Xu and Narayan, as applied to claim 1, and further in view of Cohen et al. (U.S. Patent No. 5,805,829). The Examiner rejected claims 6-7 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Xu and Narayan, as applied to claim 5, and further in view of Wang et al. (U.S. Patent No. 6,058,428). In rejecting independent claim 1, the Examiner stated:

Regarding independent claim 1, Xu discloses:

- Connection between the digital camera and the computer (figure 1; col 3, lines 55-67 to col 4, lines 1-3; col 4 lines 30-45)
- Mounting the image capture device as a disk on the host computer (abstract; col 2, lines 15-35; col. 3, lines 55-65)

Xu does not disclose generating the image files stored in the digital camera into HTML format and opening those files in the computer system without loading any

camera-specific software.

Narayan discloses:

- saving images from a digital camera to the hard disk of the computer (figure 4, steps 201, 203)
- generating an Internet page description file in the image capture device that references the images stored therein (figure 1, steps 10, 12; figure 5, steps 225, 229)
- establishing communication between the image capture device and the host computer (col 5, lines 50-67; col 6, lines 28-45)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Xu into Narayan to obtain the connection between a PC and a digital camera, and the creating a HTML file containing images from the digital camera.

Xu and Narayan do not explicitly disclose opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have known that once created, the HTML file can be viewed by the Netscape browser, which is a web browser, in the host computer without loading any communication software onto the host computer.

The Examiner also stated that “[c]laims 8, 13 are for the system and the computer-readable medium of the method claim 1, and therefore are rejected under the same rationale.” Final Office Action (07/02/01), pp. 3-4.

B. The Cited Prior Art

1. Xu (U.S. Patent No. 5,848,420)

Xu discloses a digital camera coupled to a personal computer. A software program that is loaded onto the host computer and “permanently stored in [the computer’s] memory 92” permits the computer to make the memory in the digital camera appear as a disk to the operating system

of the computer. (Abstract; col. 4, lines 4-10). Without the software program, Xu would not be able to mount the digital camera as a disk onto the computer.

2. Narayen et al. (U.S. Patent No. 6,035,323)

Narayen is directed to the distribution of a collection of digital media, such as images from a digital camera, over a network, such as the Internet. In Narayen, digital images are downloaded from the digital camera into “a digital processing system, such as a computer system.” (Col. 6, lines 31-34). Once the images are stored in the computer system, the user creates an album comprised of “album format data.” Such data includes a page layout and style of the images chosen from the downloaded images. (Col. 8, lines 10-20). The album format data and the images are then transmitted to a server computer system, where the data is stored and the images are converted into a web-viewable format. (Col. 8, lines 21-42). When a request to view the album is received by the server, the server “generates an appropriate page of an album in HTML format and sends the page to the web browser which requested a viewing of the album.” (Col. 8, lines 45-58).

3. Cohen et al. (U.S. Patent No. 5,805,829)

Cohen is directed to allowing Java applets to be executed natively over a non-IP network. Cohen notes that Java files (or applets) can be included in web pages so that the applet can execute on a user’s machine. (Col. 1, lines 23-32).

4. Wang et al. (U.S. Patent No. 6,058,428)

Wang is directed to transferring digital images on a network. A signature list containing signatures for each of the digital images for transfer is examined to determine whether each of the digital images is present. For each of the digital images determined missing, the digital image is received. Updated information is also received pertaining to each of the digital images present.

C. Xu in View of Narayen Fails to Teach or Suggest the Present Invention, as Recited in Claims 1, 8 and 13.

1. Xu in View of Narayen Fails to Teach or Suggest Mounting the Image Capture Device as a Disk on the Host Computer Without the Need for Loading Communication Software Onto the Host Computer.

Appellants respectfully submit that neither Xu nor Narayen, singularly or in combination, teach or suggest “mounting the image capture device as a disk on the host computer . . . without the need for loading . . . communication software onto the host computer,” as recited in claims 1, 8 and 13. Xu combined with Narayen teaches a digital camera coupled to a personal computer, which is further coupled to a server. The software program of Xu is loaded onto and permanently stored in the personal computer of Narayen, which allows the digital camera to appear as a disk to the personal computer. The images stored in the digital camera are transmitted via a serial communication port to the personal computer, and the user creates an album comprised of album format data referencing the images. The album format data and images are transmitted to the server, where when requested, an HTML page referencing the images is created according to the layout and style identified by the album format data. The HTML page is viewable by the requester via a web browser.

In the present invention, the digital camera identifies itself as a mass storage device class to the host computer’s operating system through communication software *in the digital camera*, not on the host computer. (Specification, page 10, lines 7-10). In response, the host computer’s operating system executes existing protocols to load the appropriate drivers to mount the digital camera as a disk volume. (Id., lines 10-13). Thus, because the present invention takes advantage of the *existing* functionality of the host computer’s operating system, there is no need to load any

type of communication software onto the host computer in order to mount the camera as a disk.

In contrast, Xu requires that its communication software be loaded into the host computer before the digital camera can be mounted to the computer. Without the software, Xu's computer does not have the ability to communicate with the digital camera as a disk.

Accordingly, Xu cannot teach or suggest "mounting the image capture device as a disk on the host computer . . . without the need for loading . . . communication software onto the host computer," as recited in claims 1, 8 and 13.

In the Final Office Action, the Examiner states:

First, the limitation "mounting the image capture device as a disk onto the host computer without the need for loading a communication software onto the host computer" is not claimed and is not the invention. Only "mounting the image capture device as a disk onto the host computer" is claimed.

Second, the limitation "without the need for loading a communication software onto the host computer" is claimed in combination with "opening the Internet page description file in a web browser on the host computer, wherein the image stored in the image capture device are displayed on the host computer through the web browser" (claim 1).

This is verified in the specification (page 1, lines 11-14, viewing images from an image capture device on a host computer, and more particularly to a method and system for viewing images from an image capture device on the host computer without having to load device-specific software onto the host).

Final Office Action, pp. 8-9.

Appellants respectfully disagree. While the Specification states that the present invention is directed to allowing a user to "*view images* from an image capture device on the host computer without having to load device-specific software onto the host" (Specification, page 1, lines 11-14), it does not support the Examiner's argument that only the step of "opening the Internet page description file" is performed "without the need for loading . . . software onto the host computer." In claim 1, steps (a) through (d) describe a "method for *viewing images* from an

image capture device on a host computer.” According to the Specification, images are viewable without having to load software onto the host. Indeed, claim 1 expressly states that the images are viewable on the host computer “without the need for loading camera-specific communication software onto the host computer.”

Based on the clear language of claim 1 and the Specification, *each step*, including the mounting step, must be performed *without having to load device-specific software onto the host*. If any one of the steps (a) through (d) required loading software onto the host, the Specification, and indeed, the whole goal of the present invention, would be contradicted.

Appellants respectfully submit that the portion of the Specification relied upon by the Examiner actually supports Appellants’ present argument. As is stated in the cited portion, “[t]he present invention relates to a . . . method and system for *viewing images* from an image capture device on the host computer without having to load device-specific software onto the host.” Claim 1 recites a “method for viewing images from an image capture device on the host computer, comprising” steps (a) through (d), “wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.” Claim 1 is consistent with the cited portion of the Specification *only* if steps (a) *through* (d) are performed without loading software onto the host.

The Specification explicitly supports the position that the step of “mounting the image capture device as a disk on the host computer” is performed “without the need for loading camera-specific communication software onto the host computer,” as recited in claim 1. The Specification states that, “[t]o identify itself as a mass storage device class to the PC’s 112 operating system 116, the digital camera 110 includes USB Mass Storage Device Class server-

software that operates in accordance with USB protocols to identify to the OS 118 that the device is a mass storage device.” Specification, page 10, lines 7-10. Because *the digital camera contains the server-software*, the host computer does not need any other software to mount the digital camera as a disk volume.

Accordingly, Appellants respectfully submit that neither Xu nor Narayen teach or suggest “mounting the image capture device as a disk on the host computer . . . without the need for loading . . . communication software onto the host computer,” as recited in claims 1, 8 and 13.

2. Xu in View of Narayen Fails to Teach or Suggest Automatically Generating an Internet Page Description File or HTML File In An Image Capture Device or a Digital Camera That References the Images Stored Therein.

Xu in view of Narayen also fails to teach or suggest automatically “generating an Internet page description file” or HTML file *in the image capture device or digital camera* that references the images stored therein, as recited in claims 1, 8 and 13. In the present invention, the image capture device or digital camera has the ability to generate the Internet description file internally. For instance, in claim 8, it is expressly recited that the “digital camera includ[es] means for generating an Internet page description file.” Thus, no other device or computer is utilized to create the Internet description file.

In contrast, digital images are *downloaded* from the digital camera into “a digital processing system, such as a computer system” in Narayen. (Col. 6, lines 31-34). Once the images are stored in the computer system, the user creates an album comprised of “album format data.” The album format data and the images are then transmitted to a server computer system, where the data is stored and the images are converted into a web-viewable format. (Col. 8, lines 21-42). When a request to view the album is received by the server, the server “generates an

appropriate page of an album in HTML format and sends the page to the web browser which requested a viewing of the album.” (Col. 8, lines 45-58).

Once the digital images are downloaded from the digital camera to the computer system, the digital camera has no other use. Thus, Narayen simply fails to teach or suggest “generating an Internet page description file” or HTML file *in the image capture device or digital camera* that references the images stored therein, as recited in claims 1, 8 and 13. In the Final Office Action, however, the Examiner argues that Narayen discloses this feature in Figure 1, steps 10, 12 and Figure 5, steps 225, 229.

Figure 1 of Narayen is an overview of a process taught in the prior art. In step 10, an image from a digital camera “is acquired.” According to Narayen, “[t]his acquisition typically occurs by a digital photography program, such as Adobe’s Photoshop, which receives the input from the digital camera and causes the inputted image *to be saved in the file management system of the computer system.*” (Col. 1, lines 56-62). In step 12, “a separate computer program, such as a web authoring software program creates HTML files.” (Col. 1, lines 62-63). Thus, the process in Figure 1 explicitly states that the *computer system* generates the HTML file.

Similarly, Figure 5 is an overview of the process taught in Narayen. Step 225 states, “acquire images and build (“author”) an album . . . that can be converted into internet-viewable format (e.g., HTML format).” Column 8, lines 11-14 states the images are “acquired *from* a digital camera, or a scanner, or from a file storage device such as a CD ROM or hard disk.” Clearly, if images are acquired *from* a digital camera, they are downloaded onto the personal computer. Step 227 states, “publish software *transmits* the album format data and signature (or images) *to a server computer system.*” As is shown in Figure 2, the server computer system 111 is a computer system separate and apart from the personal computer system 121, 125, 135, 137 to

which the digital camera is coupled. Step 229 states, “server computer system saves album format data and images in a database (images are converted into web viewable format).” At Step 233, the “server computer system generates an appropriate page of an album in HTML format and sends the page to the web browser which requested the album.” Thus, in the process illustrated in Figure 5, the *server computer system* generates the Internet viewable file.

While Narayen teaches generating web viewable pages referencing images *from* the digital camera, Narayen does not teach or suggest *generating* such web viewable pages automatically “in the image capture device” or “in the digital camera.” As stated above, Narayen teaches that the computer system (Figure 1) and the server computer system (Figure 5) generate the web viewable file. Appellants respectfully submit that neither the computer system nor the server computer system can reasonably be construed to be “an image capture device” or “a digital camera.” The fact that image data can be downloaded from the image capture device/digital camera to the computer system does not make the computer system an image capture device or a digital camera. If this were so, any device that *received* image data, such as a television set, could be construed to be an image capture device or digital camera.

Accordingly, Appellants respectfully submit that nothing in Figures 1 or 5 or the cited portions of Narayen teach or suggest automatically generating “in the image capture device” or “in the digital camera” an Internet viewable file, such as an HTML file, as recited in claims 1, 8 and 13. Claims 1, 8 and 13 are therefore, allowable over Xu and Narayen.

D. Claims 2-5, 9-10, 14-18 are Allowable over Xu and Narayen, as applied to claim 1, and further in view of Cohen.

Claims 2-5, 9-10, and 14-18 depend from claims 1, 8 and 13, respectively. Accordingly,

the arguments above apply with equal force to the dependent claims. As stated above, Cohen is directed to allowing Java applets to be transmitted and executed over a non-IP network. Cohen makes no mention or suggestion of mounting an image capture device as a disk on a host computer without the need for loading communication software onto the host computer, or generating an Internet page description file or HTML file in the image capture device or digital camera that references the images stored therein, as recited in independent claims 1, 8 and 13.

Accordingly, Appellants respectfully submit that claims 2-5, 9-10, and 14-18 are allowable over Xu in view of Narayen in view of Cohen.

E. Claims 6-7 and 19-20 are Allowable Over Xu, Narayen, and Cohen, and Further in View of Wang.

Claims 6-7, and 19-20 depend from claims 1 and 13, respectively. Accordingly, the arguments above apply with equal force to the dependent claims. As stated above, Wang is directed to transferring digital images on a network. Wang, like Cohen, makes makes no mention or suggestion of mounting an image capture device as a disk on a host computer without the need for loading communication software onto the host computer, or generating an Internet page description file or HTML file in the image capture device or digital camera that references the images stored therein, as recited in independent claims 1 and 13.

Accordingly, Appellants respectfully submit that claims 6-7, and 19-20 are allowable over Xu in view of Narayen in view of Cohen, and further in view of Wang.

IX. CONCLUSION

For the reasons discussed above, Appellants respectfully submit that claims 1-20 are allowable over the cited references. Appellants respectfully request that the final rejection of

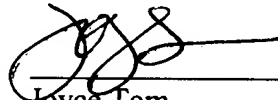
claims 1-20 be reversed.

Note: For convenience of detachment without disturbing the integrity of the remainder of pages of this Appeal Brief, Appellant's APPENDIX A is attached on separate sheets following the signatory portion of this Appeal Brief.

This Brief is being submitted in triplicate, and authorization for payment of the required Brief fee is contained in the cover letter for this Brief. Please charge any fee that may be necessary for the continued pendency of this application to Deposit Account No. 01-0365.

Very truly yours,

January 28, 2002



Joyce Tom
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IX. APPENDIX A

1. A method for viewing images from an image capture device on a host computer, comprising steps of:

- a) establishing communication between the image capture device and the host computer;
- b) automatically generating an Internet page description file in the image capture device that references the images stored therein;
- c) mounting the image capture device as a disk on the host computer; and
- d) opening the Internet page description file in a web browser on the host computer,

wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

2. A method as in claim 1 wherein step b) further includes the step of:

- i) providing Java files along with the Internet page description file in the image capture device.

3. A method as in claim 2 wherein a portion of the images in the image capture device are stored as compressed image files, step d) further including the step of:

- i) executing the Java files on the host computer for decompressing the compressed image files and for extracting information from the image files for display by the web browser.

4. (Amended) A method as in claim 3 wherein step b) further includes the step of:

- ii) automatically generating the Internet page description file when communication with the host computer is indicated.

5. A method as in claim 4 further including to step of:
 - e) storing the images displayed in the web browser on the host computer by copying the compressed image files from the image capture device directly to the host computer.
6. A method as in claim 5 wherein step e) further includes the steps of:
 - i) determining if any of the compressed image files have previously been copied to the host computer, and
 - ii) copying only the compressed image files to the host computer that have not been previously copied.
7. A method as in claim 6 further including the steps of:
 - f) uploading the Java files and the Internet page description file to the host computer, and
 - g) opening the Internet page description file in the web browser on the host computer to display the images stored in host computer.
8. A system for viewing images from an image capture device on a host computer, comprising :
 - a host computer having an operating system and a web browser; and
 - a digital camera having a plurality of images stored therein in communication with the host computer such that the digital camera appears to the host computer as a disk, the digital camera including means for generating an Internet page description file that references the stored images, wherein the Internet page description is accessible by the web browser on the host computer to enable a user to view the images on the digital camera from the host computer without the need for loading camera-specific communication software onto the host computer.
9. A system as in claim 8 wherein each image in the digital camera is stored in a

compressed image file, the Internet page description file further having associated Java files that are invoked by the web browser for decompressing the compressed image files and for extracting information from the image files for display by the web browser.

10. A system as in claim 9 wherein the means for generating the Internet page description file generates the Internet page description file in response to an indication that the digital camera is in communication with the host computer.

11. A system as in claim 10 wherein the Internet page description file is a HTML file.

12. A system as in claim 11 wherein the HTML file creates web pages that allow the user to transfer the images between the digital camera, the host computer, and the Internet.

13. A computer-readable medium containing program instructions for viewing images from a digital camera on a host computer, the program instructions for:

- a) automatically generating an HTML file that references the images stored in the digital camera;
- b) establishing a Universal Serial Bus (USB) connection between the digital camera and the host computer; and
- c) identifying the digital camera to the host computer as a mass storage device class whereby the digital camera appears to the host computer as a disk, thereby allowing a user to open the HTML file in a web browser on the host computer, wherein the images stored in the digital camera are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

14. A computer-readable medium as in claim 13 wherein instruction a) further includes the instruction of:

- i) automatically generating an HTML file in response to the digital camera

being placed into connect mode.

15. A computer-readable medium as in claim 14 wherein instruction a) further includes the instruction of:

ii) providing Java files along with the HTML file in the digital camera.

16. A computer-readable medium as in claim 15 wherein the HTML file includes an introduction page referencing an index page, further including the instruction of:

d) executing a Java Generation Applet on the host computer that scans the digital camera for images and generates the index page accordingly.

17. (Amended) A computer-readable medium as in claim 15 wherein a portion of the images in the digital camera are stored as a compressed image files, further including the instruction of:

d) executing the Java files on the host computer for decompressing the compressed image files and for extracting information from the image files for display by the web browser.

18. (Amended) A computer-readable medium as in claim 17 further including the instruction of:

e) storing the images displayed in web browser on the host computer by copying the compressed image files from the digital camera directly to the host computer.

19. A computer-readable medium as in claim 18 wherein instruction e) further includes the instructions of:

i) determining if any of the compressed image files have previously been copied to the host computer, and

ii) copying only the compressed image files images to the host computer that have not been previously copied.

20. A computer-readable medium as in claim 19 further including the instructions of:
- f) uploading the Java files and the HTML file to the host computer, and
 - g) opening the HTML file in the web browser on the host computer to display the images stored in host computer.